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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/917,134

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Jerry Pavelka

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EXAMINER

NGUYEN BA, PAUL H

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,134

Applicant(s)

PAVELKA, JERRY

Examiner

Paul Nguyen-Ba

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-12, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 14, and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This action is responsive to Applicant's Amendments and Remarks filed on June 8, 2006.
2. Claims 1-5, 7-12, 14, and 15 are currently pending. Claims 1, 8, and 15 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-3, 5, 7-10, 12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Solving Print Production Problems with Acrobat InProduction", White Paper, Adobe Systems Inc., *at least prior to April 2, 2001* (via HotBot Advanced Search Engine) (Hereinafter "InProduction"), in view of "Cropster", Gluon, Inc., 22 November 2000, pgs. 1-4 (www.gluon.com).**

The cited White Paper discusses how the Adobe Acrobat InProduction 1.0 professional toolset provides solutions to common print production problems, such as enabling bleed and trim specifications.

Regarding independent claim 1, InProduction discloses:

A method for entering advertising registration marks into an image comprising the steps of:

generating specification data for a plurality of advertising registration marks (see pg. 6 – 1st full paragraph: InProduction teaches a GUI for generating specification data for a plurality of advertising marks);

inserting a plurality of advertising registration marks into an image at locations determined by the specification data (see pg. 6 (1st full paragraph) to pg. 7 (3rd paragraph)); and

displaying the image (see Figure on pg. 6: Image is displayed).

InProduction does not explicitly disclose the newly amended language regarding accessing information “*providing a correlation between a user designation for a publication and a plurality of dimensional specifications for advertising registration marks*”. However, Cropster discloses a method for setting up page markings for bleed, trim, safety, folds and page gutters (see pg. 1- 1st paragraph). Moreover, Cropster discloses a “save presets” feature that saves time by only asking for often used settings

once. For instance, if you create a lot of two fold brochures measuring 8.5" by 11", you type in all of your parameters and save them as a preset.

Since both references are from the same field of endeavor, the motivational purpose of an efficient means of electronically setting up advertisement markings and saving redundant presets as disclosed by Cropster would have been recognized in the pertinent art of InProduction. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of InProduction with the teachings of Cropster to include providing a correlation between a user designation for a publication and a plurality of dimensional specifications by using presets for the advertising registration marks.

Independent claim 8 contains substantially similar subject matter as independent claim 1, as discussed above, and is rejected along the same rationale.

Regarding claims 2 and 9, InProduction, in view of Cropster, disclose wherein one of the advertising registration marks is a trim mark (see InProduction pg. 6 (1st full paragraph) to pg. 7 (3rd paragraph)).

Regarding claims 3 and 10, InProduction, in view of Cropster, disclose wherein one of the advertising registration marks is a bleed mark (see InProduction pg. 6 (1st full paragraph) to pg. 7 (3rd paragraph)).

Regarding claims 5 and 12, InProduction, in view of Cropster, disclose wherein one of the advertising registration marks is a gutter mark (see Cropster – pg. 1 paragraph 1 and feature 1).

Regarding claims 6 and 13, InProduction, in view of Cropster, disclose wherein the step of generating specification data is comprised of a step of accessing a computer memory containing correlation between a user designation and a plurality of dimensional specifications for advertising registration marks (see InProduction pg. 6 (1st full paragraph) to pg. 7 (3rd paragraph), and corresponding Figure).

Regarding claims 7 and 14, InProduction, in view of Cropster, disclose further comprising a step of scaling a relative size of at least one registration mark with respect to the image information (see InProduction pg. 6 – bottom two paragraphs and corresponding Figure).

Regarding independent claim 15, InProduction discloses:

generating specification data for a plurality of advertising registration marks (see pg. 6 – 1st full paragraph: InProduction teaches a GUI for generating specification data for a plurality of advertising marks);

inserting a plurality of advertising registration marks into an image at locations determined by the specification data (see pg. 6 (1st full paragraph) to pg. 7 (3rd paragraph))

InProduction does not explicitly disclose *wherein the step of inserting a plurality of advertising registration marks into an image layout occurs prior to presentation of any image data in the image layout*. Cropster discloses a "save presets" feature that saves time by only asking for often used settings once. For instance, if you create a lot of two fold brochures measuring 8.5" by 11", you type in all of your parameters and save them as a preset and they will be inserted prior to presentation of any image data in an image layout.

Since both references are from the same field of endeavor, the motivational purpose of an efficient means of electronically setting up advertisement markings and saving redundant presets as disclosed by Cropster would have been recognized in the pertinent art of InProduction. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of InProduction with the teachings of Cropster to include providing a correlation between a user designation for a publication and a plurality of dimensional specifications by using presets for the advertising registration marks that will be inserted prior to presentation of any image data in an image layout.

5. **Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Solving Print Production Problems with Acrobat InProduction”, White Paper, Adobe Systems Inc., *at least prior to April 2, 2001* (via HotBot Advanced Search Engine) (Hereinafter “InProduction”), in view of “Cropster”, Gluon, Inc., 22 November 2000, pgs. 1-4, in further view of admitted prior art (admissions – pg. 2 of Applicant’s Specification (1st – 3rd paragraphs)).**

Regarding claims 4 and 11, InProduction does not explicitly disclose *wherein one of the advertising registration marks is a “live”*.

However, Admission discloses on pg. 2 (1st - 3rd paragraphs): *wherein one of the advertising registration marks is a “live” mark* (see Applicant Specification – pg. 2 → Live marks are well-recognized in the field and may be currently generated with a variety of computer programs that are used to generate advertising image information).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include live advertising registration marks for the motivational purpose of further enhancing the ability to include a greater variety of advertising layout registration marks along with the advertising copy transmitted to the printer or publisher.

Response to Arguments

6. Applicant's arguments with respect to claims filed on June 8, 2006 have been considered but are moot in view of the new ground(s) of rejection.

The new ground(s) of rejection includes the addition of the Cropster reference, which is being relied upon for teaching the newly added limitation language regarding accessing information "*providing a correlation between a user designation for a publication and a plurality of dimensional specifications for advertising registration marks*". Applicant's arguments focus on the prior art's failure to teach this particular limitation. One of ordinary skill in the art would have been motivated at the time of the invention to arrive at the instant invention by combining InProduction and Cropster.

It is noted that the above limitation, especially regarding a "publication" significantly changes the scope of the claimed invention when interpreted as a whole.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094. The examiner can normally be reached on 11 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PNB
9/3/06

William L Bashore
WILLIAM BASHORE
PRIMARY EXAMINER